REMARKS

Summary of the Office Action

The Office Action alleges that the title is "not descriptive" and thus requires a new title.

Claim 23 is objected to as allegedly being "not decipherable."

Claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement.

Claims 1 and 21-22 stand rejected under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Publication No. 2001/0030827 A1 to Morohashi (hereinafter "Morohashi").

Claims 1-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 99/34601 to Otomo et al. (hereinafter "Otomo") further considered with U.S. Patent No. 5,619,483 to Yokota et al. (hereinafter "Yokota").

Claims 1-3 and 8-22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,987,417 to Heo et al. (hereinafter "Heo").

Claims 4-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Yokota.

Claims 23-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1 in paragraphs 10 and 11 of the Office Action, and further in view of allegedly "well known word processing nomenclature and the Dewey-Decimal system."[1]

[1] Because the Office Action does not specifically identify all of the applied references by document numbers, to clarify the record, Applicants request that the next Office Communication inform them if any of Applicants' above-stated understandings regarding the specific document numbers of the applied references are incorrect.

Summary of the Response to the Office Action

Applicants have amended claims 1 and 23 to improve their form. Accordingly, claims 1-24 remain pending. The title has been amended.

Requirement for a new Title

The Office Action alleges that the title is "not descriptive" and thus requires a new title. In response, Applicants have amended the title in accordance with the Office Action's requirement. Accordingly, withdrawal of the requirement for a new title is respectfully requested.

Objection to Claim 23

Claim 23 is objected to as allegedly being "not decipherable." Claim 23 has thus been amended to improve its form. Withdrawal of the objection to claim 23 is thus respectfully requested.

Rejections under 35 U.S.C. § 112, First Paragraph

Claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. In this regard, the Office Action alleges that "independent claim 1 is written as a single means claim." Accordingly, Applicants have amended claim 1 to improve its form by clarifying that the recited information recording apparatus includes both an "information attaching and generating device" together with a "detection device." As a result, Applicants respectfully submits that claim 1, together with its dependent claims 2-20, now fully complies with 35 U.S.C. § 112, first paragraph. Accordingly, withdrawal of the rejection of claims 1-20 under 35 U.S.C. § 112, first paragraph is respectfully requested.

Rejections under 35 U.S.C. §§ 102 and 103(a)

Claims 1 and 21-22 stand rejected under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Morohashi. Claims 1-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Otomo further considered with Yokota. Claims 1-3 and 8-22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Heo. Claims 4-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Yokota. Claims 23-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claim 1 in paragraphs 10 and 11 of the Office Action, and further in view of allegedly "well known word processing nomenclature and the Dewey-Decimal system." Applicants respectfully traverse these rejections for at least the following reasons.

Morohashi

The Office Action rejects claims 1 and 21-22 stand rejected under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Morohashi. However, Applicants respectfully submit that Morohashi does not meet the limitations of claim 1, as asserted by the Office Action because Morohashi merely discloses an apparatus which includes information for managing a plurality of music data as a music collection, and performs reproduction control by each music collection. Morohashi does not teach, or even suggest, a recording apparatus which performs grouping processing during recording of data, in the manner recited in claim 1.

Otomo in view of Yokota

Independent claim 1 also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Otomo further considered with Yokota. In particular, the Examiner states at page 5 that "[t]hese references are replied upon for the reasons stated in the submitted search report."

Applicants respectfully submit that while lines 1-2 of page 5 of the Office Action state that independent claim 1 is rejected under 35 U.S.C. § 103(a), the Office Action's subsequent language at lines 3-9 indicates that the intention of the Examiner was to reject independent claim 1 under 35 U.S.C. § 102. In particular, the Examiner applies page 35-36 of Otomo as teaching all of the limitations of independent claim 1. The Examiner then goes on to note that "[w]ith respect to the particular types further elaborated upon by the dependent claims, these are taught by the second reference to Yokata et al at the indicated passages (emphasis added)."

Regardless, Applicants respectfully submit that neither Otomo nor Yokota teach the limitations recited in at least independent claim 1. For example, the portions of Otomo applied by the Examiner refer to a user's ability to control playback of music on a DVD audio disc 10 produced with the hierarchical structure shown in Fig. 9 of Otomo. In other words, Otomo merely teaches the use of a recording medium that includes a pre-stored hierarchical structure of audio which allows a user to control the playback of the audio by, for example, jumping directly to a particular musical composition on the disc, or to a specific portion of a particular musical composition on the disc. Such an arrangement is well known in the related art.

More particularly, Otomo merely discloses a management structure for utilizing AUDIO information in both of contents recorded in DVD-AUDIO format and contents recorded in DVD-VIDEO format in the case where these contents are recorded in one recording medium. As a

result, Applicants respectfully submit that Otomo merely discloses the well-known structure of the DVD-AUDIO format, in which contents are managed hierarchically, having a first level hierarchy (group), a second level hierarchy (track), and a third level hierarchy (index) (see, for example, FIG. 9). Accordingly, Otomo disclosure merely manages contents by using a group and track. In Otomo, a user has to choose a group to record each track. Therefore, Otomo does not teach, or even suggest, a recording apparatus which performs grouping processing originally and automatically during recording of data, in the manner recited in claim 1.

The arrangements and methodologies described in the instant application, on the other hand, involve a novel way to record tracks of recorded information onto an information recording medium, by automatically grouping the tracks being recorded based on group control information generated by an information attaching and generating device, as recited in the claims of the instant application. As discussed in the specification of the instant application, the recording apparatus disclosed in the instant application greatly simplifies the recording process because users do not need to perform grouping operations themselves when recording tracks onto the medium. This is because the grouping is automatically performed when a change in track recording is detected, as recited in the claims of the instant application.

Otomo merely discloses that a user can jump to particular musical portions, that have previously been recorded on a disc, based on the recorded group information. It does not disclose an arrangement in which the user is recording tracks on the disc himself. As a result, like Morohashi discussed above, Otomo clearly does not disclose, or even suggest, an arrangement in which such grouping of tracks is automatically performed while the user is recording tracks onto a medium.

As stated in the Office Action, Yokota is applied only for the teachings of the dependent claims. Nevertheless, Applicants respectfully submit that Yokota also does not cure the above-noted deficiencies of Otomo with regard to independent claim 1. For example, Applicants respectfully submit that Yokota merely discloses a recording apparatus which automatically generates a track reference number and records the track. Therefore, Yokota does not teach, or even suggest, a recording apparatus which performs grouping processing originally and automatically during recording of data, in the manner recited in claim 1.

Heo

Independent claim 1 also stands rejected under 35 U.S.C. § 102(b) as being anticipated by Heo. Heo is directed to a DVD audio disk reproducing device and method thereof. Like Otomo, Heo does not involve an information recording apparatus for recording information onto a disc in the manner discussed in the claims of the instant application. Accordingly, Applicants respectfully submit that Heo also does not meet the limitations of independent claim 1 at least because it does not teach or suggest an information recording apparatus in which users do not need to perform grouping operations themselves when recording tracks onto the medium. Similar to the foregoing discussion with regard to Otomo, Heo also does not disclose an arrangement in which a user is recording tracks on the disc himself. As a result, Heo clearly does not disclose, or even suggest, an arrangement in which such grouping of tracks is automatically performed while a user is recording tracks onto a medium in the manner recited in the claims of the instant application. Applicants respectfully submit that Heo merely discloses a method of reproducing a DVD audio disc. Heo does not teach, or even suggest, a recording

apparatus which performs grouping processing originally and automatically during recording of data, in the manner recited in claim 1.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102 and 103(a) should be withdrawn because the applied art of record, whether taken singly or combined, do not teach or suggest each feature of independent claim 1. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicants respectfully assert that dependent claims 2-24 are allowable at least because of the dependence from independent claim 1, and the reasons set forth above. Moreover, any additional references applied against the dependent claims do not cure the above-described deficiencies of the references applied against independent claim 1.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this

application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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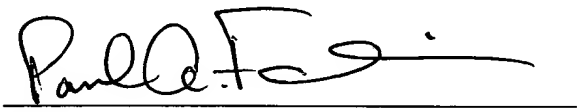
Dated: September 13, 2004 By: 

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